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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,398	12/15/2003	Henry C. Hight JR.	P-123057.1 (UTI)	6209
7590	11/17/2004		EXAMINER [REDACTED]	PATEL, VISHAL A
Daniel D. Chapman, Esq. JACKSON WALKER L.L.P. Suite 2100 112 E. Pecan Street San Antonio, TX 78205			ART UNIT 3676	PAPER NUMBER
DATE MAILED: 11/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,398	HIGHT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vishal Patel	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 August 2004.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 12-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 10 is/are allowed.

6) Claim(s) 1-9 and 12-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Penna et al (US. 3,160,251).

Regarding claim 1: Penna discloses a clip (10) comprising a head (12) having an apex (apex of 12), a pair of shoulders (shoulders of 12) and a neck (neck of figure 2 that is similar to the neck 24 of figure 1) and having a longitudinal axis (longitudinal axis of head 12). A base (portion of 10 having 14) attached to the head (head having apex), the base comprising at least one coil course (the coil formed at 14), the coil course having a radius of curvature R (radius of curvature R of the coil course), the radius of coil course (radius of the coil course) at an origin of the longitudinal axis of the head, the coil course having a plane (the coil course having 14 lines in a horizontal plane) and the longitudinal axis of the head perpendicular to the coil course and the head originating at and extending above (the head 12 extends above the coil course, see figure 2) the coil course at the center of curvature (the head is perpendicular to the coil course and is at the center of the curvature).

Regarding claim 2: The head, apex, shoulders, neck and the at least one coil course are formed from a single resilient wire (the clip is made of single resilient wire).

Regarding claim 3: The base including at least two courses (second coil course having 20) and the course furthest removed from the head includes a tail (tail 16). This is showed in figure 3 and the head still projects beyond the first coil course.

Regarding claim 4: The base includes a tail (tail 16).

Regarding claim 5: The single resilient wire has first and second ends (first end which is contained by 12 and second end near 16).

Regarding claim 6: The head includes the apex, the neck and the pair of shoulders between the apex and the neck (the head 12 includes the apex, the neck and the pair of shoulders between the apex and the neck).

Regarding claim 7: The base includes a tail portion (portion of 16 which forms base).

Regarding claim 8: The head is defined by a single plane (the head 12 which lines in a single longitudinal plane).

Regarding claim 9: The base includes multiple coils (coil course having 14 and second coil having 20, the head is above the coil course having 14).

Regarding claim 21: As seen in figure 3, each coil course has its one constant radius of curvature.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (US. 5,806,149).

Schultz discloses a sealing apparatus comprising a gasket (gasket having 12 and 16), a clip (clip of figure 6) engaged with the gasket (the clip engages the gasket), the clip having a head (head 126) and a coiled base (coiled base 124 having ends 122a and 122b), the coil base with a constant radius of curvature (coils having ends 122a and 122b have same radius of curvature). The gasket includes a woven sheath and a woven wire core (core 12 which is woven and a woven sheath 16). The clip base is comprised of wire, the wire dimensioned for insertion between weaves of the sheath and the wire core (clip of figure 6 inserted in the gasket, similar to as seen in figures 2-3). The woven wire core defines an interior space inside of the gasket and wherein the base is disposed substantially within the interior space when the clip is engaged with the gasket (the base is disposed in an interior spaced inside of the gasket, clip of figure 6 inserted in the gasket, similar to as see figure 2). The head is disposed substantially outside of the woven sheath of the gasket (when clip of figure 6 is inserted in the sheath, similar to as seen in figures 1-3). The head of the clip defines an apex (apex on top of shoulders 126a and 126b), shoulders (126a and 126b) and a neck (neck near C). The neck lays adjacent weaves of the sheath and the wire core when the clip is engaged with the gasket (when the neck is inserted in the gasket, similar to as seen in figures 1-3). The base of the clip lies in a first plane (plane of 124) and the head of the clip lies in a second plane (plane of 126). The planes being substantially perpendicular (the planes are perpendicular). The base includes a multiplicity of courses (course having 122b and course having 122a). The base includes a tail (tail 122b). Schultz discloses the invention substantially as claimed above but fails to disclose that the head extends at the center

of curvature. Penna discloses (in figure 2) a clip used to secure a member (22) to a second member (32) by having a head (12), a coil course base (base having 14) and the head projecting above the coil course. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the clip of Schultz to be replaced by a clip as taught by Penna to reduce cost and to secure the gasket to a second member (since there is only a single set of coil courses which would reduce cost).

***Allowable Subject Matter***

5. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive.

Applicants' argument that Penna does not disclose a head above the base having the coil course is not persuasive because as seen in figure 2, Penna has a head having two shoulders and an apex that extends above a coil course having 14.

Applicants' argument that Bolduce and Bono fail to anticipate the current amended claims 5 and 9-10 and 12-20 is persuasive so this rejection is withdrawn.

Applicants' argument against claims 12-20 is moot in view of new rejection above.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is (703) 308-8495. The examiner can normally be reached on Monday through Friday from 7:30 PM to 4:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. Technology Center 3600 Customer Service is available at 703-308-1113. General Customer Service numbers are at 800-786-9199 or 703-308-9000. Fax Customer Service is available at 703-872-9325.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:** 703-872-9326, for formal communications for entry before Final action; or, 703-872-9327, for formal communications for entry after Final action.

Hand-delivered responses should be brought to Crystal Park Five, 2451 Crystal Drive, Arlington, Virginia, Seventh Floor (Receptionist suite adjacent to the elevator lobby).

VP  
November 10, 2004



ALISON PICKARD  
Primary Patent Examiner  
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